

REMARKS

Regarding the Office Action

Claims 24-46 are pending and under current examination. Applicants have amended claims 24-46 to improve form, provide proper antecedent basis for claim terms, and to improve clarity. In the Office Action, the Examiner rejected claims 24-28, 30-38, and 40-46 under 35 U.S.C. § 102(b) as being anticipated by U.K. Patent Application GB 2 319 694A to Manssen *et al.* ("*Manssen*"); and rejected claims 29 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Manssen* in view of U.S. Patent Application No. 2002/0122550A1 to Noplock ("*Noplock*").

In light of the foregoing amendments and based on the arguments presented below, Applicants respectfully traverse the rejections.

Regarding the 35 U.S.C. § 102(b) Rejection of Claims 24-28, 30-38, and 40-46

Applicants respectfully request reconsideration and withdraw of the rejection of claims 24-28, 30-38, and 40-46 under 35 U.S.C. § 102(b) as being anticipated by *Manssen*. In order to establish anticipation under 35 U.S.C. § 102, the Examiner must show that each and every element as set forth in the claim is found, either expressly or inherently described, in *Manssen*. See M.P.E.P. § 2131.

Manssen does not disclose each and every element of Applicants' claimed invention. Specifically, *Manssen* does not disclose or suggest at least Applicants' claimed "processing a calling line identity presentation supplied by a communications network to a called user following a call made by a calling user in said communications network, . . . and inserting said identification code into said calling line identity presentation," as recited in independent claim 24 (emphasis added). Instead, *Manssen* discloses a system for editing a received telephone number in a radiotelephone device,

i.e., within the mobile phone of the called user. See *Manssen*, Abstract, and FIG. 2, step 66. That is, *Manssen* does not “[process] a calling line identity presentation supplied by a communications network to a called user following a call made by a calling user in said communications network.” Under the system disclosed in *Manssen*, the called user would have to edit in his/her telephone the telephone number of the caller in order to place a reply call to that person.

Since *Manssen* fails to disclose at least Applicants’ claimed “processing a calling line identity presentation supplied by a communications network to a called user following a call made by a calling user in said communications network, . . . and inserting said identification code into said calling line identity presentation,” as recited in independent claim 24, *Manssen* does not anticipate Applicants’ claim 24. Independent claim 24 should therefore be allowable. Independent claim 35, although of differing scope, recites elements similar to those of independent claim 24, and should therefore be allowable for at least the same reasons. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and request allowance of independent claims 24 and 35, as well as their respective dependent claims 25-34 and 36-46.

Regarding the 35 U.S.C. § 103(a) Rejection of Claims 29 and 39

Applicants respectfully request reconsideration and withdraw of the rejection of claims 29 and 39 under 35 U.S.C § 103(a) as being unpatentable over *Manssen* in view of *Noplock*.

The Examiner has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*,

383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007). In particular, the Examiner has not properly determined the scope and content of the prior art, at least because he incorrectly interpreted the content of *Manssen*. Specifically, *Manssen* does not teach what the Examiner attributes to *Manssen*, as explained previously.

Moreover, the Examiner's arguments do not provide an appropriate supporting rationale to support his conclusion of obviousness regarding at least independent claims 24 and 35 in light of the decision by the Supreme Court in *KSR* that would enable "prompt resolution of issues pertinent to patentability." See M.P.E.P. § 2141(III). It appears that the Examiner attempted to rely on a rationale that there exists "[s]ome teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." M.P.E.P. § 2143. See also M.P.E.P. § 2143(G). The Examiner improperly applied this rationale, at least because the alleged motivation to combine *Manssen* with *Noplock* is based on mere conclusory statements. See Office Action, p. 4.

Applicants note that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. § 2143.01(IV) (citations to *KSR* and *In re Kahn* omitted). The Examiner's conclusory statements along with the incorrect characterization of the cited prior art references undermines the Examiner's allegations and clearly demonstrates nonobviousness of the claimed invention.

None of the cited references, whether taken alone or in combination, teaches or suggests each and every element of Applicants' independent claims 24 and 35, and therefore claims 29 and 39. Moreover, one of ordinary skill in the art at the time of the present invention would not have been motivated to modify *Manssen* with *Noplock* to produce the claimed invention. For example, as explained above, *Manssen* does not teach or suggest "processing a calling line identity presentation supplied by a communications network to a called user following a call made by a calling user in said communications network, . . . and inserting said identification code into said calling line identity presentation," as recited in independent claims 24 and 35.

Additionally, *Noplock* fails to cure the deficiencies in *Manssen*. In particular, *Noplock* discloses a telephone appliance for appending service provider's long distance dial-around prefix numbers for a calling user. See *Noplock*, paragraph [0033], and Abstract. The telephone appliance is located between the telephone jack and the telephone. See *Noplock*, FIG. 1. This clearly does not constitute "processing a calling line identity presentation supplied by a communications network to a called user following a call made by a calling user in said communications network, . . . and inserting said identification code into said calling line identity presentation," as recited in independent claims 24 and 35, and required by dependent claims 29 and 39.

In view of the reasoning presented above, Applicants submit that claims 29 and 39 are not obvious over *Manssen* in view of *Noplock*, at least because the Examiner has not properly resolved the *Graham* factual inquiries, and has not provided an appropriate supporting rationale to support his conclusion of obviousness. See M.P.E.P. § 2141(II) and (III). Moreover, the Examiner has not shown that the results of combining *Manssen* with *Noplock* would have been predictable. See M.P.E.P.

§ 2143.01(III) ("the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citation to *KSR* omitted)). The reasoning presented above disproves the Examiner's allegations and clearly demonstrates nonobviousness of the claimed invention. Claims 29 and 39 should therefore be allowable, and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection.

Conclusion

Applicants respectfully request reconsideration of the application and withdrawal of the rejections. Pending claims 24-46 are neither anticipated nor rendered obvious in view of the cited references. Accordingly, Applicants request allowance of the pending claims.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
David M. Longo
Reg. No. 53,235

Dated: July 3, 2008

/direct telephone: (571) 203-2763/